SUPREME COURT OF THE UNITED STATES.

Samuel Castner, Jr., and Henry B. Curran, trading under the firm name and style of Castner & Curran, Petitioners,

vs.

W. H. Coffman, doing business under the name and style of Pocahontas Coke and Coal Company and W. H. Coffman Coke Company.

October Term, 1899.

No. 113.

ON WRIT OF *Certiorari* TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE FOURTH CIRCUIT.

BRIEF ON BEHALF OF PETITIONERS.

HISTORY OF THE LITIGATION.

This cause was originally brought by the petitioners in the Circuit Court of the United States for the District of West Virginia. The bill of complaint (pages 2-6, Record) sets forth that the petitioners are the owners of a trade mark or name, "Pocahontas," for coal of a bituminous or semi-bituminous nature, and that the respondent, W. H. Coffman, under the fictitious name of Pocahontas Coke and Coal Company and other names, had infringed thereon. Accompanying the bill when filed were numerous affidavits

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and exhibits in support of the bill and in support of a motion for a preliminary injunction. Upon the argument of said motion before the Circuit Court, the respondent first interposed a demurrer to the bill (pages 72-74), which, after full argument, was overruled (page 75), and thereafter filed an answer accompanied by affidavits and exhibits in opposition to the motion for preliminary injunction. The petitioners thereupon filed certain affidavits in rebuttal, and upon the record thus formed, and after a lengthy argument for and against the motion, the Circuit Judge granted the motion. This order of the Circuit Court is found at pages 145, 146, Record, and from this order the respondent appealed to the United States Circuit Court of Appeals for the Fourth Circuit. The Circuit Court of Appeals thereafter reversed the order of the lower court and ordered that the bill of complaint be dismissed. The opinion of the Circuit Court of Appeals will be found at pages 147-158, Record, and its decree thereon at page 158, Record.

Before the mandate of the Circuit Court of Appeals on said decree had issued, the petitioners filed a petition for rehearing in order that the mandate to be issued by the court should direct that both parties proceed to final hearing upon pleadings and proofs. (Record, pages 158, 159.)

This petition was denied (page 160, Record), and thereafter the mandate directing the dismissal of the bill of complaint was issued. (Page 162, Record.)

To review the record and proceedings before the Circuit Court of Appeals, these petitioners filed in this court on the eighteenth day of August, 1898, a petition for writ of *certiorari*, which petition was granted and the writ issued on the twenty-fifth day of October, 1898. The writ of *certiorari* with the return was filed in this court on the twenty-second day of November, 1898.

As appears by said petition for writ of *certiorari*, the questions of law and of fact presented to the Circuit Court of Appeals for the Fourth Circuit were also presented to the Circuit Court of Appeals for the First Circuit, which latter court rendered its opinion after the two opinions of

the Fourth Circuit had been handed down, and with full knowledge of said opinions.

The opinions of the two Circuit Courts of Appeal are widely divergent: the Fourth Circuit holding that as a matter of law and of fact, the petitioners have no right to the trade mark or name "Pocahontas," whereas the First Circuit has held that as a matter of law and of fact these petitioners have a right to appropriate said name "Pocahontas" as their exclusive trade mark.

The opinion of the Circuit Court of Appeals for the First Circuit is reported in 88 Fed. Rep., 642, and its opinion on a petition for rehearing is reported in 90 Fed. Rep., 828. The main opinion will also be found at pages 12 to 15 of the motion papers filed in this court on the eighteenth day of August, 1898, upon the motion for writ of *certiorari*. For the convenience of the court, copies of both opinions of the First Circuit are appended to this brief.

STATEMENT OF THE CASE.

The record in the court below which forms the return to the writ of *certiorari* of this Honorable Court, discloses the following facts:—

I. That petitioners are residents and citizens of the State of Pennsylvania, and the defendant is a resident and citizen of the State of West Virginia.

II. That the amount in controversy in this cause, as appears by the bill of complaint (page 5 of Record), is in excess of the sum of $10,000.

III. That this suit was brought to restrain the said defendant, W. H. Coffman, from infringement of petitioners' trade mark "Pocahontas" as applied to coal.

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IV. That the petitioners derived title to this trade mark by an assignment under date of April 1st, 1895, from the South-West Virginia Improvement Company to your petitioners. (Pages 10 to 12, Record.)

V. That the undisputed facts relating to the adoption and use of "Pocahontas" as a trade mark for coal by the South-West Virginia Improvement Company, may be briefly stated as follows:—

In the year 1881 the tract of land in which the coal is now mined was an unexplored wilderness (see Record, pages 134, 135); that the only name given to the region at that time and for years afterward was the Great Flat Top Region (page 135, Record); that during the years 1881 and 1882 the South-West Virginia Improvement Company developed this wilderness, opened coal mines, built many houses for the reception of its employees, and in other ways converted the wilderness into a hive of industry (page 135, Record); that during the year 1882 the said South-West Virginia Improvement Company adopted the name or symbol "Pocahontas" as a trade mark for its output of coal (page 13, Record); that the town near which the mines of the South-West Virginia Improvement Company were located was founded by the said company (page 13, Record); but said town was not incorporated and had no legal existence until January 31st, 1884, when by Act of the Legislature of Virginia it was so incorporated (see Act of Incorporation, pages 54-59, Record); that long after the coal of the South-West Virginia Improvement Company had become well established and known in the markets of the world as "Pocahontas" coal, the region from which it comes was colloquially named the Pocahontas Coal Field; that prior to the opening of the mines of the South-West Virginia Improvement Company, coal was not known to exist in any quantity in this region, and being a wilderness, remote from railways, and without even carriage or wagon roads, and practically without population, this section of the country had no

distinctive designation or geographical name. (See page 134, Record.)

VI. That the record shows that after the adoption and use of the trade mark "Pocahontas" by the said South-West Virginia Improvement Company, and prior to the year 1884, Castner & Co., Limited, the predecessors of petitioners, purchased, inspected, and purified the coal mined by said South-West Virginia Improvement Company and shipped and sold said inspected and selected coal, principally at tidewater points, under the name of "Pocahontas" coal; that thereafter, about the year 1889, the petitioners succeeded to the business of said Castner & Co., Limited, and became the sole agents and licensees of the said South-West Virginia Improvement Company in the sale of coal mined by said company, which coal was uniformly inspected, selected, and sold for twelve years by the petitioners and their predecessors, with the license and permission of the said South-West Virginia Improvement Company, as "Pocahontas" coal; and that since the assignment of the said trade mark in 1895 the petitioners, as owners of said trade mark, have continuously inspected, selected, and sold coal under the said trade mark or name of "Pocahontas." (See Bill of Complaint, sections III., IV., V., VI., pages 2 and 3, Record; also pages 12, 13, Record.)

VII. That the inspection, selection, and grading of their coal prior to its sale under the name of "Pocahontas" was and is necessary to preserve to the coal a uniform and standard quality, and involves the expenditure yearly of many thousands of dollars and the employment of from one to two hundred men (page 32, Record); and that in this inspection, selection, and grading the men employed are under the control of petitioners, and are compelled by petitioners to observe many rules and regulations, as appears by said rules and regulations, which are printed *in extenso* at pages 32-34, inclusive, of the record.

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VIII. That by reason of their care in the selection, inspection, and grading of their coal, and an enormous outlay of money in the advertising for sale and in the selling of their coal as "Pocahontas" coal, these petitioners have built up and maintained a business wherein the sales of coal amount annually to nearly three million tons. (See page 15, Record.)

IX. That the public and dealers in coal uniformly acquiesced in the right of Castner & Co., Limited, and of these petitioners to the use of said trade mark "Pocahontas" up to the time when the defendant, Coffman, began the acts complained of in the bill of complaint, that is to say, up to about the first day of November, 1896. (See pages 14, 15, Record.)

X. That the acts of the defendant complained of and proven by the record was as follows:—

(*a.*) The selling and advertising for sale, at reduced prices, of inferior coal by defendant as "Pocahontas" coal. (Record, pages 40, 41, 46.)

(*b.*) The assumption by the defendant, Coffman, of the name of Pocahontas Coke and Coal Company, a company which exists only in the mind of the defendant, and was assumed solely for the purpose of deceiving the public. (Record, page 15; defendant's answer, section XIII., pages 85, 86, Record.)

(*c.*) The selling of coal by defendant as Pocahontas coal, which coal had not been inspected, selected, and graded prior to its delivery to the customer. (See Record, pages 38, 39.)

(*d.*) The actual deception of certain persons of the trade who purchased coal from the defendant under the supposition that it was petitioners' Pocahontas coal, said customers having bought the coal on the strength of the assertion of defendant that it was the same as petitioners' Pocahontas coal. (See Record, pages 40, 41; see also letter of defendant's agents, Rowe & Woodruff, page 123, Record.)

HISTORY OF COMPLAINANT'S TRADE MARK.

In the year 1881, that part of the county of Tazewell, in which the first mine of the South-West Virginia Improvement Company was located, was a wilderness "remote from railways and without even carriage or wagon roads, and practically without population," and without distinctive designation (page 134, Record), the only name given to the region at that time and for years afterwards being "Flat Top" or "Great Flat Top Region" (page 135, also Exhibit A, page 16; also defendants' proof, pages 87, 88, 104, &c.) In the year 1881 this wilderness was explored by Frederick J. Kimball, then connected with the Norfolk and Western Railroad Company, and he discovered that coal of a bituminous or semi-bituminous nature could easily be mined therein. (Page 53.) He interested capitalists who acquired the charter of the South-West Virginia Improvement Company, a corporation which had been organized by the legislature of Virginia in 1880. (Page 7, Record.) Early in the year 1882 this company began operations. It opened and developed coal mines and marketed the product, and the coal produced was called "Pocahontas" coal. (Kimball, pages 53 and 54, Record.) This is corroborated by Welch. (Record, page 135.) The word "Pocahontas" was never used or suggested in connection with this region until after it had been adopted by the South-West Virginia Improvement Company in 1882, as a name for its coal. (Pages 12 and 13, also page 134.)

It appears that the coal was not marketed in very considerable quantities until the branch of the Norfolk and Western Railroad to the coal fields was completed, which was early in the year 1883. (Page 54, page 100.) The complainants have adduced some records showing the use of the name Pocahontas as a particular designation of the coal sold by the South-West Virginia Improvement Company at the seaport of Norfolk, Va., in the year 1883. This evidence consists of sundry letters, bills, &c. The earliest in date is a letter from an agent of the Improvement Com-

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pany, dated July 5th, 1883, wherein it is stated that a certain testimonial confirms the views of the writer, which he has held all along, that "the Pocahontas coal is the best steam coal in the market." (Pages 60, 61, Record.)

Next is a receipt for $812.35 for twelve cars "Pocahontas" coal (over two hundred tons). This is dated July 30th, 1883. (Page 61, Record.) Several invoices are produced (page 62, Record) showing sales of about five hundred tons of coal by the South-West Virginia Improvement Company, to different parties, wherein all of the coal is particularly designated as "Pocahontas" coal.

The defendant shows by its exhibit (page 103, Record) that over sixty thousand tons were sold by the South-West Virginia Improvement Company in 1883. It likewise shows by the same exhibit (page 100, Record) that in 1882 the shipment from the mines, when first opened, was from two to three hundred tons per day. All this was "Pocahontas" coal.

The name "Pocahontas" became geographical in the sense of designating a distinctive part of the State of Virginia in January, 1884, when the town of Pocahontas, located in Tazewell County, was incorporated by the legislature of Virginia. (Page 55, Record.) Thereafter, as abundantly appears from the record, the coal was mined in ever-increasing quantity, until at the time of bringing this suit, the annual production amounted to nearly three million tons of "Pocahontas" coal. (Page 15.) Even after its incorporation in 1884, there were "thousands of people in the State who did not know there was such a place as 'Pocahontas.'" A big explosion at the mines, a terrible disaster, first attracted the attention of outsiders to the *place*. (Defendant's Exhibit, page 100, Record.)

Other mines were opened in addition to the original mines of the South-West Virginia Improvement Company, which were given various names. (Pages 105-109, Record.) Coal from all these mines was handled and sold by Castner & Curran, the present complainants, and by

their predecessors, Castner & Co., Limited, and all that which was of a suitable quality of excellence was marketed as "Pocahontas" coal from 1882 to the time of bringing suit. (Pages 32-34.) This is established by the agreements of December 29th, 1884 (pages 16-25, Record), between the Norfolk and Western Railroad Company, the South-West Virginia Improvement Company, the Flat Top Coal Company, and a number of other coal operators and Castner & Co., Limited, whereby the latter firm was appointed tidewater agents for the sale of all of the coal of said mines, and in turn agreed not to sell any other bituminous or semi-bituminous coal than that covered by said agreements; also by the affidavit of Mr. Castner (page 12, Record), where he says (page 13) that the firm of Castner & Co., Limited, had, previous to the making of said agreements, received coal from the South-West Virginia Improvement Company, which it had sold as "Pocahontas" coal; also that after the making of said agreement Castner & Co., Limited, up to 1889, and thereafter their successors, Castner & Curran, continued the sale of said coal under said agreements by the license and permission of the South-West Virginia Improvement Company, up to March 26th, 1895.

On March 26th, 1895, Castner & Curran became *general agents* for the sale of all coal mined in the "Great Flat Top Region." (Page 13, Record.)

On April 1st, 1895, by an assignment dated on that day, Castner & Curran acquired the title of the South-West Virginia Improvement Company to the trade mark "Pocahontas." (Page 10, Record.)

In this assignment the significant statement is made that the trade mark "Pocahontas" was *adopted* by the South-West Virginia Improvement Company about July 1st, 1882. (Page 10.)

Mr. Castner states in his affidavit that from 1883 up to the time of bringing suit the complainants and their predecessors have continuously acted as factors and agents for the sale of coal from the Great Flat Top district under the distinctive title of "Pocahontas" or "Pocahontas Flat

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Top." (Page 13.) He also states that the complainants and their predecessors have expended large amounts of money in the

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of said coal, and in maintaining its superior quality and in advertising the same as "Pocahontas." (Page 13.)

In Mr. Curran's affidavit it is stated that the output from the various mines varies greatly in quality and purity. (Page 32.) That when Castner & Co., Limited, began to handle coal from the said region it established a system of inspection and selection of the coal prior to its shipment from each mine, and that this system was continued up to the time of bringing suit. Castner & Curran place at the "tipple" of each mine a sub-inspector and several assistants, and they have a superintendent and two chief inspectors and assistants.

During 1896 the complainants, to insure the high standard of the Pocahontas coal, employed from one to two hundred men in inspecting coal, and many thousands of dollars in salaries were spent for that purpose.

This was necessary to bring the products of the various mines to a uniform standard of excellence, and the continued practice of the complainants in this regard has resulted in the enormous increase in the demand for the "Pocahontas" coal. (Page 32, Record.)

Mr. Curran also produces as a part of his affidavit the rules laid down by the complainants for the guidance of the inspectors, which are printed at pages 32, 33, and 34, and from which it will be apparent that this inspection is deemed of paramount importance by complainants.

The *Iron Belt* for October, 1891 (page 98), exhibited by the defendant, has the following in relation to the care displayed in grading and selecting the Pocahontas coal:—

> *"In getting out coal for shipment every ton is required to come up to a certain standard, which it is needless to say is high, otherwise it is condemned. That 'Pocahontas' coal is of superior quality has been demonstrated by careful analysis."*

ARGUMENT.

In this cause the Circuit Court of Appeals for the Fourth Circuit, as appears by its two opinions, considered that but one vital proposition of law should be considered. This proposition can perhaps be better stated in the form of a question, which has been decided by the Circuit Court of Appeals for the Fourth Circuit in the negative.

This question, which is broad enough, perhaps, to cover all other questions involved in this case, is as follows:—

CAN A GEOGRAPHICAL NAME UNDER ANY CIRCUMSTANCES BECOME THE SUBJECT MATTER OF A TRADE MARK?

In answering this question the Fourth Circuit in its opinion upon the petition for rehearing (Record, page 160), held that—

> *"the word 'Pocahontas' could not be exclusively appropriated by the complainants as a 'trade mark' or 'word symbol,' for the reason that it was and is a geographical word. * * * We are clearly of the opinion, not only that the complainants below are not entitled to an injunction, but also that there is no equity in their bill."*

Referring to the opinion upon the appeal, it will be found that the proposition of law advanced by the Fourth Circuit, to the effect that under no circumstances can a geographical name be appropriated as a trade mark or name, apparently is predicated primarily upon the decisions of the Honorable Supreme Court of the United States. These decisions are Canal Company *vs.* Clark, 13 Wall., 311; and Columbia Mill Co. *vs.* Alcorn, 150 U. S., 460.

According to petitioners' contention both in the Fourth and First Circuits, these two cases can readily be distinguished from the case at bar.

Thus the petitioners contended that in the first of these cases it was held that the words "Lackawanna Coal" could not constitute a valid trade mark, the word "Lackawanna" *having been in common use to designate the locality from which both complainants' and defendant's coal*

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was obtained long prior to the mining of coal by complainants.

In the second of these cases it was held that the word "Columbia" *was one primarily of geographical significance,* and could not be appropriated as a trade mark by the complainant. It was also held in this case that the complainant was not the first to use the word "Columbia" to designate flour.

In the case at bar the bill alleges and the record shows that "Pocahontas" was not in common use to designate the locality from which both complainants' and defendant's coal was obtained long or at any time prior to the mining of coal by complainants' predecessors. On the contrary, the proof is undisputed that the South-West Virginia Improvement Company gave the name "Pocahontas" to its coal, to its mines, to its mining village, and to its post office, and long before the name "Pocahontas" came into general or any use to designate the locality in which the coal was found.

Thus Welch, a pioneer in the field, testifies (Record, page 135) that in 1881 the tract of land in which the mines are situated *was a wilderness;* that in 1881 and 1882 the South-West Virginia Improvement Company opened its mines, built many houses for the reception of its employees, and in other ways converted the wilderness into a hive of industry; that the coal region in which the town of Pocahontas was and is situated has uniformly been known as the Great Flat Top region and that no coal district, region, or field in either Virginia or West Virginia was known geographically or geologically as "Pocahontas" prior to the mining of coal by said South-West Virginia Improvement Company.

But irrespective of the particular facts in the case at bar (which facts will be discussed in a subsequent portion of this brief), the interpretation which the Circuit Court of Appeals for the Fourth Circuit has given to the decisions in the "Lackawanna" and "Columbia" cases is directly at variance with the interpretation of these cases given by various courts throughout the United States.

The Lackawanna case was considered by the Court of Appeals of Kentucky in Metcalfe *vs.* Brand, 5 So. W. Reporter, 773-778, and it was held therein that—

> *"The right of one person to appropriate the name of a region of country to the exclusion of others who produce or sell a similar product of the same region, may be regarded as settled by the Supreme Court in Canal Co.* vs. *Clark, 13 Wall., 311, commonly known as the Lackawanna coal case. Lackawanna is the name of a considerable region of country. Lackawanna coal is a natural product of that region, and the name was descriptive of the general character or quality of the product. * * * Being generic and thus descriptive, it was held that each of the contestants had a right to call his coal 'Lackawanna Coal,' but this case cannot be regarded as holding that the name of a place can under no circumstances become a trade mark."*

In Pillsbury Washburn Flour Mills Co. *vs.* Eagle, 86 Fed. Rep., 608, it was held by the Circuit Court of Appeals for the Seventh Circuit, that the true rule laid down by this court in the "Lackawanna" and "Columbia" cases was that

> *"irrespective of any question of trade marks, rival manufacturers have no right by imitative devices to beguile the public into buying their wares under the impression that they are buying those of their rivals."*

In the Pillsbury case it was further held (page 617):—

> *"So in the case at bar, the complainants can have no exclusive right to the use of the geographical names 'of 'Minneapolis' or 'Minnesota.' They are not the subject of a trade mark proper. Any one or more of the two hundred thousand inhabitants of Minneapolis may use that word upon their flour. The defendant or any other person from any State may go there, and establish a mill, and brand his flour 'Minnesota Patent' and 'Minneapolis, Minnesota.'*

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The defendant might have continued to buy Minneapolis flour and branded it 'Minneapolis, Minn.,' and had all the benefit which these marks would give him in the market, because he would be adhering to the truth and fair dealing. But when he places these same brands upon another flour manufactured in Wisconsin, he departed from the truth and placed a lying brand upon his goods, which was intended to deceive, and could not but deceive, the public, and result in injury to the complainant's business. If the defendant could do this, all other persons could do the same thing, and so the public would be defrauded, and the goodwill and business of complainants, which has taken thirty-nine years to build up, would be greatly impaired, if not destroyed. If this could be permitte', there would not be much incitement to provide the public with a high grade of flour, such as the complainants have been manufacturing for many years, and which the evidence shows had led the markets of the world, if, by all manufacturers using the same brand, the complainants' flour may be confounded with all lesser grades and kinds made from all sorts and grades of wheat."

Also at page 627, the court said:—

"The cases in which a person has been enjoined from using his own name in connection with other labels or brands upon his goods proceed upon the same general ground of deceit and unfair competition in trade. If a person may be restrained from the use of his own name upon his own goods, because such use in the circumstances will deceive the public into puchasing his goods, believing them to be the goods of another, to the injury of the public and the goodwill and business of such other person, so, also, on the like principle may he be restrained from using any other proper or geographical name when such use will produce like results."

In Illinois Watch Case Co. *vs.* Elgin Nat. Watch Co., 94 Fed. Rep., 667, the Circuit Court of Appeals for the Seventh Circuit again affirms the doctrine in the Pillsbury case.

In the *Waltham Watch Case* (Am. Waltham Watch Co. *vs.* The U. S. Watch Co., 53 N. E. Rept., 141), the Supreme Court of Massachusetts applied the same doctrine as was announced in the Elgin case cited above.

The case of Glendon Iron Co. *vs.* Uhler, 75 Pa., 467, 15 Am. Rep., 599, was relied upon by the defendant before the Circuit Court of Appeals, and was quoted from by the Fourth Circuit in support of its opinion. We call the attention of the court to the fact that a report in full of this Glendon case is only found in the 75 Penna. Reports, and that in 15 Am. Rep. the report is misleading, because important facts are therein omitted. If that case is cited as sustaining the proposition that every person living or carrying on business at a certain place has a right to use the name of the place to indicate the origin of the goods, then this case is in direct conflict with the later decisions in the "Elgin," "Waltham," and "Minneapolis Flour" cases. But we do not so read the "Glendon" case.

In Gebbie *vs.* Stitt, 82 Hun., 93 (1894), plaintiffs, previous to 1891, had long manufactured plows at Deer River, N. Y., and their plows became generally known as "Deer River Plows." They were stamped on the top of the beam, "Deer River." Plaintiffs moved to Lowville, N. Y., in 1891, but continued to manufacture plows stamped "Deer River" as before. Defendant, in 1893, bought original plow works at Deer River and manufactured the same kind of plow as the plaintiffs, and stamped them "Deer River" on the top of the beam, and on the side of the beam "L. E. Stitt, M'F'R. Deer River, N. Y." On application for preliminary injunction, it was said by Merwin, J. (page 98), that the defendant—

> *"was in the attitude of committing * * * upon the plaintiffs a fraud by inducing persons to deal with him under the belief that they were dealing with the*

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person, or true representatives of the person, who had given a reputation to the name."

Defendant, accordingly, enjoined from—

*"manufacturing, selling, or in any way or manner disposing of * * * plows bearing, in any manner or form whatever, the name 'Deer River' as a name or trade mark, or any name like or similar thereto, which might deceive or tend to deceive the public to plaintiffs' harm."*

In Montgomery *vs.* Thompson (1891), App. Cas., 217, these facts appeared:—

Stone is a town of about six thousand inhabitants. Plaintiffs and their predecessors had operated continuously the only brewery in the place since 1780. Defendant shortly before the suit erected a brewery in Stone, and marked his ale "Stone Ale" and "Stone Ales." It was not disputed that under these appellations plaintiffs' ale had won and enjoyed a considerable reputation. "A trader," said Lord Watson (v., page 217), "who buys ale under one or the other of these designations relies upon its having been manufactured by the plaintiffs; and even those consumers who do not know the manufacturer or the place of manufacture, expect to get the same ale which they have been in use to purchase, namely, the plaintiffs'." Defendant was unconditionally enjoined in the Court of Appeals from selling his ale under the term "Stone Ale" or "Stone Ales." He appealed, and contended that he had a right to use those words so long as he used them in combination with other words which sufficiently distinguished his manufacture from that of plaintiffs'.

It was said by Lord Herschell, L. C. (page 220):—

"I do not think the principles on which the court ought to act in such a case as the present is open to doubt. The respondents are entitled to ask that a rival manufacturer shall be prevented from selling

*his ale under such a designation as to deceive the public into the belief that they are obtaining the ale of the respondents, and he ought not the less to be restrained from doing so, because the practical effect of such restraint may be much the same as if the persons seeking the injunction had a right of property in a particular name. * * * The injunction might, no doubt, have been framed in more general terms; * * * but had it been so, the same question as has been discussed at the bar would have arisen on an application to commit the defendant for breach of injunction in respect of selling his ale as 'Stone Ale'; and the court having come to the conclusion that he could not sell the liquor manufactured by him under that name without inducing the belief in the mind of the purchaser that he was obtaining the plaintiffs' ale, a conclusion from which I see no ground for differing. I do not think it was improper to frame the injunction in the form accepted, and thus to determine the question at once instead of leaving it to be raised and contested on an application to commit."*

It was said by Lord Watson (page 221):—

*"The precise terms in which an injunction ought to run must depend upon the particular facts of the case. In the present case I feel somewhat hampered by the consideration that the only appeal is at the instance of the defendant, and the injunction cannot recast in any way to his disadvantage. Had the matter been open, I should have preferred an order restraining the defendant 'from using the word "Stone" as descriptive of or in connection with ale or beer manufactured by him, or ale or beer (not being of plaintiff's manufacture) sold or offered for sale by him without clearly distinguishing such ale or beer from the ale or beer of the plaintiffs'. * * * But it appears to me that an injunction in these or similar terms would involve a prohibition against selling ale or beer*

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other than the plaintiffs' under the terms 'Stone Ales' or 'Stone Ale,' and might, in other respects, be more stringent than the order as settled by the Lords Justices."

Lord Hannen said (page 227) that:—

"The appeal to this House is based on the contention that the word 'Stone,' in connection with ale or beer, is merely used by the appellant in a geographical sense, as indicating that the ale or beer is manufactured at that place, and that any one is entitled to use it in that sense, provided he does not use it so as to induce the belief that his goods are the goods of manufacturers previously established at Stone. The principle contended for by the appellant may be admitted as correct, but in considering what may induce purchasers to believe that the appellant's goods are the goods of the respondents, all the circumstances of the case must be taken into account. Here the evidence has satisfied Chitty, J., and the Court of Appeal, and, I think, ought to satisfy your Lordships, that the respondent's goods had acquired by long usage the name of 'Stone Ale' and 'Stone Ales'; that that name does not merely convey the idea that the beer was manufactured at Stone, but that it was ale of the respondent's manufacture. The appellant is undoubtedly entitled to brew ale at Stone, and to indicate that it was manufactured there, but there are various means of stating that fact without using the name which has now become the designation of the respondent's ale."

Lord Macnaghten said (page 224):—

"I do not see any way to alter it" (i. e., *the injunction*) *"at all, except in making it more stringent and more severe, and that would be hardly fair to the appellant on his appeal. I think that an order in the terms read by my noble and learned friend opposite"*

(Lord Watson)—"an injunction in the form of that granted in Seixo vs. *Provezende—would have better met the justice of the case. * * * It is obvious, I think, that if the injunction had been in that form, the appellant could not have used the term 'Stone Ales' at all. It would have been impossible for him to have called his ales 'Stone Ales' and to have distinguished his ales from those of the plaintiff. Any attempt to distinguish the two, even if honestly meant, would have been perfectly idle."*

The injunction appealed from and affirmed, restrained defendant, *inter alia*, from selling or causing to be sold any ale or beer not of plaintiffs' manufacture under the term "Stone Ale" or "Stone Ales," or in any way so as to induce the belief that such ale or beer is of the plaintiffs' manufacture.

In Atwater *et al. vs.* Castner *et al.*, 88 Fed. Rep., 642-43, the Circuit Court of Appeals for the First Circuit thus interprets the rule of this court with relation to geographical names as laid down in the "Lackawanna" and "Columbia" cases:—

"It is said that the complainants' coal, and also the alleged infringing coal, come from an extensive locality now generally known under the name of Pocahontas, and it is claimed that the case thereto falls within the rule of Canal Company vs. *Clark (13 Wall., 311, and the Columbia Mills Company* vs. *Alcorn, 150 U. S., 460. But even if this were true in a general sense, it would remain to be considered whether the Supreme Court, in Singer Manufacturing Company* vs. *June Manufacturing Company, 163 U. S., 169, 203, 204, was not compelled to a qualification of the broad principle claimed to have been stated in the cases referred to, as applied to trade marks and trade names which have been long and extensively used, and have become widely recognized by the public at large, even when they might not*

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have originated in accordance with the ordinary rules of law. In that case the court found that some qualification of the rule that a word which indicates quality cannot be protected as a trade mark or trade name is necessary, at least in some classes of cases, and there is ground for maintaining that this applies with the same necessity to trade marks and trade names which represent well-known localities as to those of the character of that in question in that case. We do not, however, find it necessary to decide at present whether or not any qualification of that nature would be applicable to the case at bar, because so sharp a question does not now arise. Some of the reasons which render it necessary, under some circumstances, to protect, at least to a qualified extent, a trade mark of a geographical origin, were given by us in Levy vs. Waitt, 61 Fed. Rep., 1008, 1012; S. C. 10 C. C. A., 227.

"The exact rule of Columbia Mills Company vs. Alcorn is implied in the following statement, at page 464 (150 U. S.):—

"'The word "Columbia" is not the subject of exclusive appropriation, under the general rule that a word or words in common use as designating locality or section of a country cannot be appropriated by any one as his exclusive trade mark.

"This is explained in the same opinion, at page 465, by citing from Canal Company vs. Clark, ubi supra., *the following expression:—*

"'The word "Lackawanna" was not devised by the complainants. They found it a settled and known appellative of a district in which their coal deposits and those of others were situated. At the time they began to use it, it was a recognized description of the region, and, of course, of the earth and minerals in the region.'

"It is necessary to recognize carefully the distinction which these expressions imply. Otherwise, a manu-

facturer, producer, or dealer who furnishes goods of such excellent quality that they build up so extensive a trade as to give a distinctive name to the locality where it is pursued, would be defeated of the just fruits of his industry and integrity by the very fact of his own meritorious conduct. Therefore, even under the rule as stated in the Columbia Mills Company vs. *Alcorn*, ubi supra, *and without the qualification recognized in Singer Manufacturing Company* vs. *June Manufacturing Company*, ubi supra, *the case at bar as presented to the court below and also to this court, involves a difficult question of fact, to the effect whether at the time the trade mark or trade name in question was adopted, the word Pocahontas was in common use as designating a known locality, or whether the locality gained its name from the complainants."*

In the case at bar, the bill of complaint was dismissed and no opportunity given to present the facts of the case on final hearing solely because the Circuit Court of Appeals for the Fourth Circuit found that "Pocahontas" was and is a geographical word, and that, therefore, "further proofs relating to the same would be unavailing."

This was defendant's main defense. (Record, page 29, letter of defendant to petitioners under date of November 12th, 1896.)

In the cases cited above, the Court of Appeals of Kentucky, the Circuit Court of Appeals for the Seventh and the First Circuits have held that whether or not a geographical name can be appropriated as a trade mark depends upon the particular circumstances of each case.

IN THE CASE AT BAR THE FACTS, WE BELIEVE, ARE SUCH AS TO CLEARLY DISTINGUISH THE PRESENT CASE FROM EITHER THE "LACKAWANNA" OR THE "COLUMBIA" CASES.

The bill of complaint in the present case alleges (Record, page 2):—

"I. That heretofore and about the year 1882, in the State of Virginia and county of Tazewell, in said

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State, a tract or field of smokeless bituminous or semi-bituminous coal was opened and mined.

"II. That during said year 1882, the first mine in said region or field was opened and operated in Tazewell County, Virginia, by the South-West Virginia Improvement Company, a corporation duly organized and transacting business under the laws of the State of Virginia, a copy of the charter of said corporation being hereto annexed and marked 'Exhibit A.' That shortly thereafter, but still in the year 1882, the said corporation, the South-West Virginia Improvement Company, named their mine Pocahontas, and began selling their coal therefrom as 'Pocahontas coal,' having adopted the trade mark 'Pocahontas' as designating its said output."

These allegations are not successfully denied. They are supported by the affidavits of Castner (Record, pages 12 and 13); Kimball (Record pages 53, 54, also page 134); and Welch (Record, page 135).

Kimball testifies (pages 53, 54, Record), as follows:—

"That he was president of the Norfolk and Western Railroad Company for thirteen years, beginning with the year 1883, and for several years prior thereto he was vice-president of said company; that during the year 1881 while he was connected with the said company he explored that portion of Tazewell County, Virginia, at which the coal mine of the South-West Virginia Improvement Company is now situated, and found that coal of a bituminous or semi-bituminous character could be easily mined in large quantities at that place; that this deponent was instrumental in securing capital for the development of the region thereabouts, and succeeded in interesting capitalists who acquired the charter of the South-West Virginia Improvement Company, a company which had been incorporated by Act of the Legislature of Virginia in March 1880, and the said company then began the erection of the necessary plant and the construc-

tion of the necessary machinery for the mining of coal in said Tazewell County, Virginia; that the mines of said South-West Virginia Improvement Company were opened and developed early in the year 1882 and before the middle of said year, but coal was not shipped in large quantities until the completion of the branch of the Norfolk and Western Railroad Company to the coal fields and mine openings designated the 'East' Mine and 'West' Mine, which was in the year 1883; that prior to the building of this branch railroad and opening of the said mines, this section of the country was a wilderness; that deponent remembers the history of these early transactions, because as an officer of said Norfolk and Western Railroad Company he was interested in developing traffic for his railroad from the said mines; that some time about the middle of the year 1882, the said South-West Virginia Improvement Company called their settlement and post office Pocahontas, and upon the completion of the branch of said road the station was called 'Pocahontas' and the coal mined and marketed under the name and style of 'Pocahontas' coal; and thereafter, to wit, in 1884, the town of Pocahontas was incorporated, as appears by a certified copy of its charter, marked 'Exhibit Pocahontas Charter,' hereto annexed. The said coal was sold as 'Pocahontas' coal in 1883, as appears by a copy of the 'Exhibit, Collins Receipt,' hereto annexed. The mining town of Pocahontas was created by the above efforts to mine said coal, and did not exist until the miners and others who took part in these efforts settled in said wilderness."

He further testifies (page 134, Record) that:—

"Prior to the opening of the mines of the South-West Virginia Improvement Company, coal was not known to exist in any quantity in this region and being a wilderness, remote from railways, and with-

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out even carriage or wagon roads, and practically without population, this section of country had no distinctive designation."

To the same effect is the affidavit of Welch. (Record, page 133.) In the *Iron Belt* of October, 1891, offered in evidence by defendants, the foregoing history of the development of this coal field is corroborated. (Record, pages 99 and 100.)

We have therefore at the outset a very different state of affairs in the present case from that in either the "Lackawanna" or "Columbia" cases.

As Mr. Justice Strong said, speaking for the court in the "Lackawanna" case:—

"Whether the name 'Lackawanna Coal' was devised or adopted by them as a trade mark before it came into common use is not so clearly established. On the contrary, the evidence shows that long before the complainants had commenced their operations, and long before they had any existence as a corporation, the region of country in which their mines were situated was called 'The Lackawanna Valley'; that it is a region of large dimensions, extending along the Lackawanna River to its junction with the Susquehanna, embracing within its limits great bodies of coal lands, upon a portion of which are the mines of the complainants, and upon other portions of which are the mines of the Pennsylvania Coal Company, those of the Delaware, Lackawanna and Western Railroad Company, and those of other smaller operators. The word 'Lackawanna,' then, was not devised by the complainants. They found it a settled and known appellative of the district in which their coal deposits and those of others were situated. At the time when they began to use it it was a recognized description of the region, and of course of the earths and minerals in the region."

This language undoubtedly distinguishes the "Lackawanna" case from the "Pocahontas" case, for when the

South-West Virginia Improvement Company began to mine their coal in Tazewell County they found "no settled and known appellative of the district in which their coal deposits and others were situated," which appellative was "Pocahontas." On the contrary, they CREATED that appellative "Pocahontas" to distinguish their mines and coal from the "settled and known appellative of the district," which was "Great Flat Top" or "Flat Top."

In the "Columbia" case, Mr. Justice Jackson, speaking for the court, said:—

> *"The word 'Columbia' is not the subject of exclusive appropriation under the general rule that the word or words in common use as designating locality or sections of a country cannot be appropriated by any one as his exclusive trade mark."*

Amplifying this doctrine the Justice further held:—

> *"The appellant was no more entitled to the exclusive use of the word 'Columbia' as a trade mark than he would have been to the use of the word 'America,' or 'United States,' or 'Minnesota,' or 'Minneapolis.' These merely geographical names cannot be appropriated and made the subject of exclusive property. They do not, in and of themselves, indicate anything in the nature of origin, manufacture, or ownership; and in the present case the word 'Columbia' gives no information on the subject of origin, production, or ownership."*

In the case now before the court the word "Pocahontas" was not in common use in 1882, when adopted by the complainants' assignor, to designate any locality or section of any country. When adopted it did clearly indicate origin and ownership. It was *the* Pocahontas coal and mine of the South-West Virginia Improvement Company.

The bill of complaint in the present case (Record, page 4) also contains the following allegations:—

> *"XI. And your orators further show unto your Honors that the defendant, W. H. Coffman, is a*

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factor or agent engaged in the sale of coal and coke at Bluefield, West Virginia, and elsewhere, and amongst other things he sells and advertises for sale are bituminous and semi-bituminous coals from the Indian Ridge Colliery, situated in West Virginia, which coals are inferior in quality and purity to the coal of your orators, said coal of the defendant not being of the standard established by your orators, but being greatly inferior thereto in respect to quality, purity, and also in respect to size.

"XII. Yet your orators aver and charge, that the said defendant, well knowing the premises, and intending and contriving to deceive dealers in coal and the public and to cause purchasers of coal sold by the said defendant to believe that the same was sold your orators, or is of the quality of that sold by your orators, has at Bluefield, West Virginia, in the District of West Virginia, and elsewhere, unlawfully offered for sale and sold a very inferior and a very impure coal under the name and designation of 'Pocahontas,' and has and is accompanying the offer as well as delivery of said inferior and impure coal with letters, notes, and bills, whereon the word symbol 'Pocahontas' is prominently displayed, and in which the words 'Pocahontas' coal or 'Pocahontas' Flat Top coal, or sundry abbreviations thereof, appear in a most conspicuous manner, and that purchasers or would-be purchasers of his inferior and impure coal are liable to be and will be deceived by the representations of the said defendant into purchasing the coal of defendant as your orator's superior and specially selected coal; and your orators aver and charge it to be a fact that purchasers have heretofore been so deceived, and that the reputation of your orator's 'Pocahontas' coal has thereby been tainted, and that the defendant intends to and will continue the aforesaid unlawful acts unless prevented by this Honorable Court; and that in this unlawful business the said defendant and his confederates are and have been engaged since about the month of November, 1896."

And these allegations are supported by numerous affidavits (Castner, Record, pages 14-15; Matson, Record, pages 34-35; Shirey, Record, pages 35-36; Hurst, Record, pages 37-38; Wilcox, Record, page 39; Calfee, Record, page 40; Sayers, Record, page 41; Stockham, Record, pages 42-43; Wales, Record, pages 43-44; Barney, Record, page 45; Claxton, Record, pages 46-47; Alkins, Record, pages 48-49; Mather, Record, page 51).

The above averments were not made in the bill of complaint in the "Lackawanna" case.

In the "Lackawanna" case, the court said:—

> *"It may be observed there is no averment that the other coal of the Lackawanna Valley differs at all in character or quality from that mined on the complainants' lands. On the contrary, the bill alleges that it cannot easily be distinguished therefrom by inspection. The bill is therefore an attempt to secure to the complainants the exclusive use of the name 'Lackawanna coal' as applied, not to any manufacture of theirs, but to that portion of the coal of the Lackawanna Valley which they mine and send to market, differing neither in nature or quality from all other coal of the same region.*
>
> *"Undoubtedly words or devices may be adopted as trade marks which are not original inventions of him who adopts them, and courts of equity will protect him against any fraudulent appropriation or imitation of them by others. Property in a trade mark, or rather, in the use of a trade mark or a name, has very little analogy to that which exists in copyrights or in patents for inventions. Words in common use, with some exceptions, may be adopted if at the time of their adoption they were not employed to designate the same or like articles of production. The office of a trade mark is to point out distinctively the origin or ownership of the article to which it is affixed; or, in other words, to give notice who was the producer. This may in many cases be done by*

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a name, a mark, or a device well known, but not previously applied to the same article. But though it is not necessary that the word adopted as a trade name should be a new creation, never before known or used, there are some limits to the right of selection. This will be manifest when it is considered that in all cases where rights to the exclusive use of a trade mark are invaded, it is invariably held that the essence of the wrong consists in the sale of the goods of one manufacturer or vendor as those of another, and that it is only when this false representation is directly or indirectly made that the party who appeals to a court of equity can have relief."

In the "Columbia Mills" case, these averments were made, but were not properly supported by the proofs, for in the "Columbia" case this court said (page 467):—

"It is also shown by the testimony in this case that the flour manufactured from Spring wheat, such as that dealt in both by the complainant and the defendants, is never sold or bought simply on the brand, but usually, if not always, by actual sample, and the proof fails to establish that the brand of the appellees was calculated to mislead, or did actually deceive or mislead, any one into supposing that the flour of the complainant was being bought. So it cannot be said that the defendants were personating the complainants' business by using such a description or brand as to lead customers to suppose that they were trading with the appellant."

These averments, supported as they are by voluminous proof and practically uncontradicted by the defendant, are sufficient, we believe, to again distinguish the case at bar from the "Lackawanna" and "Columbia Mills" cases.

In a subsequent portion of this brief, the proofs relating to the defendant's infringing acts and conduct will be considered more in detail. It is sufficient to state here that enough is proven to show that there is an equity in the

bill of complaint which the Fourth Circuit failed to discover when it dismissed the bill of complaint and refused the petition for rehearing.

The bill of complaint (Record, page 3) also contains the following averment:—

> *"VIII. And your orators further show unto your Honors, that they have devoted much time and expended large sums of money in inspecting, selecting, grading, and otherwise maintaining the superior quality and purity of the said coal, whereby the same has acquired and now possesses a great reputation in the markets of the world under the name of 'Pocahontas' coal or 'Pocahontas' Flat Top coal, and has been and is much sought after under the name or trade-mark 'Pocahontas' by dealers and by the public; and your orators aver that by reason of the premises the sole and exclusive right to the use of the word-symbol 'Pocahontas' as a trade mark for coal is now vested in your orators, and is of great value to them in their said business."*

The affidavits of Castner (Record, pages 13, 14); Curran (Record, pages 32-34); Shirey (Record, pages 36, 37); Hurst (Record, pages 37, 38); and Wilcox (Record, page 39) support these averments and show that after the coal is mined and prior to its acceptance and sale by appellees and complainants, a rigid system of grading, selection and inspection is in use at each mine controlled by complainants, so that before its sale to the public the complainants' coal reaches a certain standard of excellence. The appellant's Exhibit "Iron Belt" at page 98, Record, likewise shows that such inspection is made and is necessary. And through complainant's excesive care in the selection, grading, and inspection of their coal, through the expenditure of upwards of $26,000, and through skill, industry, and extensive advertisements in pushing the sale of said coal, the complainants have succeeded in building up a trade for Pocahontas coal which amounts to three million tons a year.

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No such averment and no such proofs were offered in the "Lackawanna" case nor in the "Columbia Mills" case, and hence the case at bar can be again distinguished from both of said cases.

The present case, however, appears to be on all fours with the case of Menendez *vs.* Holt, 128 U. S., 514-525, in which Mr. Chief Justice Fuller, in his statement of the case, said of the complainants:—

> *"That they were the owners of a certain trade mark for flour which consisted of the fanciful words 'La Favorita,' which was originated by the firm and had been used by it for more than twenty years to distinguish a certain flour of their selection and preparation; that said firm at all times exercised great care in the selection, packing, and preparation of the flour packed and sold by them under the said brand 'La Favorita,' and has carefully advertised the same, and by their care and efforts extensively introduced it to the trade, so that the said brand had come to be widely known and sought after by the trade, and the sale of flour so branded constituted an important part of the firm's business."*

Under this statement of facts the defendants and appellants claimed that the words "La Favorita" were descriptive of the properties, style, or quality of the flour, and hence could not be appropriated as a trade mark. This contention was disposed of by the court in the following language:—

> *"The fact that Holt & Co. were not the actual manufacturers of the flour upon which they had for years placed the brand in question, does not deprive them of the right to be protected in the use of that brand as a trade mark.*
>
> *"They used the words 'La Favorita' to designate flour selected by them, in the exercise of their best judgment, as equal to a certain standard. The brand did not indicate by whom the flour was manufactured,*

but it did indicate the origin of its selection and classification. It was equivalent to the signature of Holt & Co. to a certificate that the flour was the genuine article which had been determined by them to possess a certain degree of excellence. It did not, of course, in itself indicate quality, for it was merely a fancy name and in a foreign language, but it evidenced that the skill, knowledge, and judgment of Holt & Co. had been exercised in ascertaining that the particular flour so marked was possessed of a merit rendered definite by their examination and of a uniformity rendered certain by their selection."

Having established satisfactorily, as we think, that the present case may be distinguished from the "Lackawanna" and "Columbia" cases, if the averments of the bill of complaint are true, the next question which naturally arises is as to whether or not the averments of the bill of complaint have been proven. In this connection this Honorable Court should not overlook the fact that the record is made up of *ex parte* affidavits which were used upon an application for a preliminary injunction. And the further fact should be considered that the Fourth Circuit has held, in substance, on the petition for rehearing, that even if the allegations or averments of the bill were satisfactorily proven, yet such proof could not avail as there is no equity in the bill as framed.

Whether the opinion of the Fourth Circuit upon the appeal be casually or carefully read, it is apparent that in that opinion the court held that the averments of the bill were not proven, but in the opinion upon the petition for rehearing, the Fourth Circuit burned all bridges and announced that its first opinion unqualifiedly meant that no geographical term or name could form the subject matter of a trade mark, irrespective of whether the term or name was adopted as a trade mark prior to its use as a geographical name or not.

Complainants aver that the South-West Virginia Improvement Company, from which they derive title to the

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trade mark by assignment, adopted the name "Pocahontas" as a trade mark early in the year 1882, and thereafter gave that name to its mines, its mining village, and its post office. Irrespective of the complainants' affidavits to this effect, the defendant has offered as an exhibit into this case a publication called the "Iron Belt," dated October, 1891, and extracts from that publication are printed at pages 97-102 of the Record. The following quotation (pages 99, 100) is sufficient, we believe, to confirm complainants' contention:—

> *"The developments in the Flat Top coal field started in the Fall of 1881, but only surface work on the side of the mountain was done. In January, 1882, about twenty miners were landed at the point in Tazewell County, Virginia, where now stands the town of Pocahontas, then a howling wilderness, having taken nine days to make the trip from New York, the greater part of the time having been consumed in making their way across the mountains from Wytheville. A place was cleared away and a shanty was erected, in which the men cooked their meals and had their sleeping apartments. The first work done by these men was the clearing of a passageway up Laurel Creek. This creek was so named from the large amount of laurel bush that lined the banks of the stream, and which, in some places, was so dense that it almost excluded daylight. Mr. William T. Moore, an old and respected citizen of Abb's Valley, tells of shooting an enormous bear on Laurel Creek one afternoon about sunset, and when he returned next day to secure his game he could not make his way to the spot on account of the denseness of the undergrowth. So much for this digression.*
>
> *"The wet season in the Spring of 1882 retarded the progress of the work, which was all out of doors, but in March, that year, the first blast was put in the east mine, and on April 1st Mr. Thomas C. Blair,*

now a successful capitalist of Roanoke, Va., closed a contract with the South-West Virginia Improvement Company to run the No. 1 east mine one mile, also the air course and the No. 1 west mine. The work was then pushed with vigor till Fall, when it was stopped for a time on account of the inability of the railroad to reach the mines, in consequence of all the coal taken from the mine being dumped in front of the opening.

"The New River Division of the Norfolk and Western Railroad was completed in 1883, and the first carload of the product of the new coal field was shipped through to Norfolk and distributed among the poor. When the car left Pocahontas it was decorated with branches of laurel, and as it passed through the various towns along the route, the people, realizing that the completion of the Norfolk and Western Branch road to the coal mines would mark the beginning of a new era in the history of our development, in their enthusiasm, draped the car with bunting and flags, and when it arrived at Norfolk it was one mass of red, white, and blue."

This Honorable Court will also see from the defendants' own showing that to the South-West Virginia Improvement Company in 1882, *"when the mines were first opened a shipment of two or three hundred tons per day was considered a great output."* (Record, page 100.)

The Fourth Circuit has stated (Record, page 155) that:—

> "The first coal sent to market, according to the evidence, was in July, 1883, at which date both the town of Pocahontas and the post office of the same name had been in existence for a year at least."

It is true that the first shipments of coal by rail from the mines to the seaport of Norfolk, Va., did not take place until 1883, because the railroad had not been completed until that year, but it is also true that the *very first*

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shipment placed upon the Norfolk market was sold as Pocahontas coal. Thus Lamb testifies (Record, page 60) that

> *"in 1883 he was appointed agent for the South-West Virginia Improvement Company for the sale of their coal mined in Tazewell County, Virginia, which coal was put upon the market as 'Pocahontas' coal."*

He produces a letter of E. S. Hutchinson (Record, pages 60, 61), a receipt (Record, page 61), and copies of certain invoices (Record, page 62) in corroboration of his testimony.

With regard to the existence of the town of Pocahontas and the post office of the same name, the defendants' exhibit from the "Iron Belt" has this to say (Record, page 100):—

> *"When the mines were first opened a shipment of two and three hundred tons per day was considered a great output, but when the big explosion took place in the year 1884, the daily output was many times greater than this. This explosion was beneficial to the new coal fields, inasmuch as it attracted the attention of the public to it. At that time there were thousands of people in the State who did not know there was such a place as Pocahontas, or had not heard of the wonderful developments going on there."*

This quotation from a magazine published in 1891, nearly six years before this suit was brought, is, we think, the very best evidence and was evidently overlooked by the Fourth Circuit, when, in its opinion (Record, page 155), it said:—

> "We are impelled to find from the testimony that in the early shipments of coal the word Pocahontas was used, not as a word-symbol or trade mark, but simply as the name of the town from whence it came,

> for the purpose only of pointing out the place of production. The coal had not then been used, and it had not produced the wonderful results that it subsequently did; its reputation had not been made, and it had not at that time found its way to the marts of the world—to the furnaces of land and sea."

It is further in evidence that the town of Pocahontas had no *legal* existence until January 31st, 1884, when it was incorporated by an Act of Assembly of the State of Virginia. This Act will be found at pages 55-59, Record. Before this incorporation the land, buildings, post office, mines, and accessories were all the property of the South-West Virginia Improvement Company, and the town of Pocahontas was as much their private estate as was "Glenfield," the private estate of the plaintiff in Wotherspoon *vs.* Currie, L. R., 5 H. L. App., 512. In commenting upon this "Glenfield" case, the Supreme Court of Pennsylvania in "Laughman's Appeal," 128 Penna. State Repts., pages 1-23, said (page 23):—

> *"It is doubtless true, as a general proposition, that the name of a private estate may be used by the owner as a trade name. The case just cited is an illustration in point; for the plaintiff, in that case, at first manufactured starch on the private estate of Glenfield, and called his starch 'Glenfield.' He removed from his private estate but retained for his starch manufactured elsewhere the same trade mark, and his right to do so was sustained."*

The record, we believe, sustains the proposition that the fame of the coal gave the name to the geographical locality—changed in fact the geographical name of Flat Top or Great Flat Top to that of "Pocahontas." A question then naturally arises as to whether or not the incorporation of the town of Pocahontas in 1884, and the subsequent use of the name of Pocahontas as a common appellation of the public for the district in which the coal is mined vitiates the petitioners' right to the word as a trade mark.

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As appears from the affidavits of Castner, Kimball, and Welch, previously referred to, in 1882, when the word "Pocahontas" was adopted by the South-West Virginia Improvement Company, the district or field in which the coal was found was a wilderness with no known appellation. In the latter part of the year 1884, even after the town of "Pocahontas" had been incorporated, the district or region was still known as the Great Flat Top Region. See Exhibit Contracts A and B, Record, pages 16 and 23.)

It is a fact that the region is still known geographically as the Great Flat Top District. (See defendant's advertisement, page 47, Record.) Still it may be conceded that at the present time this Great Flat Top Region is called by many the Pocahontas Coal Field. But under well-established decisions this SUBSEQUENT use by the public of "Pocahontas" to designate locality cannot avoid the rights of appellees to the word "Pocahontas" as a trade mark in the sale of coal. To this point the case of Celluloid Manufacturing Company *vs.* Cellonite Mfg. Co., 32 Fed Rep., 94, is directly applicable.

Mr. Justice Bradley, at page 98, thus enunciates the rule:—

> *"The complainant's assignors, the Hyatts, coined and adopted the word when it was unknown and made it their trade mark, and the complainant is assignee of all the rights of the Hyatts. When the word was coined and adopted it was clearly a good trade mark. The question is whether the subsequent use of it by the public, as a common appellative of the substance manufactured can take away the complainant's right. It seems to me that it cannot."*

Again, in Selchow *vs.* Baker, 93 N. Y., 59, the New York Court of Appeals, through Judge Rapallo, said:—

> *"Our conclusion is that where a manufacturer has invented a new name, consisting either of a new word or words in common use, which he has applied for the first time to his own manufacture, or to an article*

manufactured by him, to distinguish it from those manufactured and sold by others, and the name thus adopted is not genuine, or descriptive of the article, its qualities, ingredients, or characteristics, but is arbitrary or fanciful, and is not used merely to denote grade or quality, he is entitled to be protected in the use of that name, notwithstanding that it has become so generally known that it has been adopted by the public as the ordinary appellation of the article."

See also—

Celluloid Mfg. Co. *vs.* Read, 47 Fed. Rep., 712-714;
Williams *vs.* Adams, 8 Biss., 452.

At the time in 1882 when the predecessors in interest of complainants and appellees adopted the word "Pocahontas" as their trade mark for coal, such adoption was the legitimate adoption of a fanciful name for a legitimate trade mark. At that time there was no geographical location implied by such selection. If since that time a geographical name has become coupled with the complainants' excellent product, the subsequent acts leading to such a geographical intermingling cannot vitiate the rights to the trade mark which were admittedly adopted and which were admittedly legitimate at the time of the adoption. If this were not the true rule, the Glenfield Starch case and the Celluloid decision would be erroneous in their conclusion, and any one could vitiate an existing valuable trade mark by simply starting a town or village or post office by the name of such valuable trade mark and sell his competing product by that name. Take, for example, the term "Apollinaris," which to-day appears to be a valuable trade name for certain mineral water. According to the theory of the defendant any one could now or hereafter, by merely naming a village "Apollinaris," sell some water from that village by that trade name. The weakness of defendant's case lies in this, that he overlooks the fact that at the time of *adoption* the term "Poca-

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hontas" was a valid trade mark; that in no manner have the complainants or their predecessors abandoned their rights to this trade mark, and that consequently no acts of others could in any manner oust them from its possession.

DEFENDANT'S ACTS.

Defendant admits that he has offered for sale and sold coal as "Pocahontas" (Exhibit K, pages 29, 30, Record; Exhibit I, page 31, Record).

The specific acts of the defendant complained of and proven by the Record are as follows:—

I. The selling and advertising for sale, at reduced prices, of inferior coal by defendant as the Pocahontas coal of complainant.

To prove this charge the complainants have introduced the affidavit of Castner (Record, page 14), who testifies:—

> *"That lately this deponent began to receive from the customers and agents of Castner & Curran and from others advices to the effect that 'Pocahontas' coal was being offered for sale at a reduced price, thereby lessening the sales of said agents; that immediately this deponent investigated the matter and found that one W. H. Coffman, of Bluefield, W. Va., was advertising, shipping, billing, and delivering coal mined in West Virginia at the Indian Ridge Mine, in an extension of the said Great Flat Top Coal Field, and inferior in quality to that dealt in by the said firm of Castner & Curran, which coal is designated and sold by the said W. H. Coffman as coal from the 'Pocahontas' Flat Top District, a district which in fact does not and never did exist; that the said Coffman has created in the minds of the public, dealers, and consumers of 'Pocahontas' coal the false impression or idea that the said Coffman has the right to sell and in fact is selling 'Pocahontas' coal."*

The affidavits of Mattson (Record, pages 34, 35); Calfee (Record, page 40); Sayers (Record, page 41); Stockham (Record, page 42); Wales (Record, pages 43, 44); Barney (Record, page 45); Claxton (Record, pages 46, 47); Alkins (Record, pages 48, 49); and many exhibits corroborate Mr. Castner's testimony in this regard.

II. The defendant has assumed the name of the Pocahontas Coke and Coal Company in order to further his schemes to deceive the public. It is admitted by defendant's answer (XIII., pages 85, 86, Record) that there is in fact no such "company."

III. Defendant has sold uninspected, unselected, and ungraded coal to customers as "Pocahontas" coal.

Upon this point the witness Shirey testifies in his affidavit (Record, page 36) as follows:—

> *"This deponent is familiar with the output of what is known as the Indian Ridge Mine; that previous to November 1st, 1896, the output of this mine was sold by Castner & Curran; that to render the coal from this mine fit for consumption a most rigid inspection was necessary prior to its shipment from the mine; that Castner & Curran had at this Indian Ridge Mine prior to November 1st, 1896, one sub-inspector and four assistants, that number being absolutely necessary to bring the output up to the standard of the other coal sold by Castner & Curran as 'Pocahontas' coal; that all coal from the Indian Ridge Mine prior to November 1st, 1896, was shipped by this deponent solely as 'run of mine' coal, for use for steaming and blacksmithing purposes, because there were no machinery or appliances at said mine, whereby said run of mine coal could be graded or assorted into lump and nut coal to be adapted for domestic uses, and which coal so assorted commands a better price than the run of mine coal upon the market; that since No-*

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vember 1st, 1896, Castner & Curran have not handled the coal of said Indian Ridge Mine, neither have they inspected the same, but a W. H. Coffman has handled this coal, and what inspection has been done has been at the instance of the mine operators, the Indian Ridge Coal and Coke Company; that this deponent has seen many cars of this coal so shipped by the said Coffman, and the quality of said coal is greatly inferior to the coal formerly shipped by this deponent for the said firm of Castner & Curran from the said Indian Ridge Mine; that deponent has seen coal shipped by said Coffman as lump, egg, or nut coal which was not lump, egg, or nut coal, but was simply run of mine of inferior quality and containing many impurities, such as bone coal, slate, and sulphur bands."

This is corroborated by the affidavits of Hurst (Record, page 38); Wilcox (Record, page 39); Calfee (Record, page 40); and Sayers (Record, page 41).

The affiants, Calfee and Sayers, are both coal dealers and they testify emphatically that the coal they bought of the defendant, Coffman, was *"unsatisfactory and full of impurities"* and was *"inferior in quality and purity to the 'Pocahontas' coal purchased from Castner & Curran."*

IV. The defendant in selling his coal has deceived the trade in that he has asserted that his coal so sold was the same as complainants' Pocahontas coal.

The affidavit of Calfee (Record, page 40) on this point is clear. He states:—

"That he is a resident of Wytheville, in the State of Virginia; that he is engaged in the coal and other mercantile business thereat; that heretofore he has purchased of Castner & Curran many tons of their 'Pocahontas' coal, which has uniformly given satisfaction; that on or about the thirteenth day of November, 1896, he received from the Pocahontas Coke and Coal Company, of Bluefield, W. Va., a postal

card soliciting an order for 'Pocahontas' coke, which postal was so worded as to lead this deponent to believe that he could purchase 'Pocahontas' coal from the said Pocahontas Coke and Coal Company, of Blue field, W. Va.; that in subsequent correspondence with W. H. Coffman, of said Pocahontas Coke and Coal Company, the said Coffman represented his alleged company's coal as 'Pocahontas' Coal, upon which representation this deponent purchased from said Pocahontas Coke and Coal Company about seventy-five tons of such coal; that the coal so purchased of the Pocahontas Coke and Coal Company was unsatisfactory, being full of impurities which are not present in the coal purchased by this deponent from the said Castner & Curran."

See also affidavit of Sayers. (Record, page 41.)

As to how the conduct of the defendant is viewed by his own agents, the following letter, printed at 123, Record, is instructive:—

"Rowe & Woodruff, dealers in coal, wood, coke, hay and "feed. W. Main St.

"Battle Creek, Mich., Dec. 3, 1896.

"Pocahontas Coal & Coke Co., Bluefield, W. Va.

"Gentlemen:—Enclosed find a copy of a communication which we fail to understand We have bought several cars of coal of you as Pocahontas coal, and have sold it as such We like your coal very well so far, and if we are to be protected in the sale of it; hope to do a very fair business with you. Of course our trade is not a large one, as this is a small city—about 18,000 but we have handled over 700 cars of coal in the last year, and some of our steam customers are leaning toward smokeless coal. We have heretofore used the Turkey Knob with excellent satisfaction, and have made no effort to obtain Pocahontas. A small firm, whose name and local

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reputation we will not here mention, have claimed to have the exclusive agency for Pocahontas coal and have been selling at a fancy figure, feeling confident that they had a monopoly on this coal; meantime, we have tried your coal and like it. We do not wish to get in any trouble, but perhaps we are unnecessarily alarmed. Will we be compelled to drop your coal, or will you protect us in selling what we buy as what we buy? Kindly give this your immediate attention, and oblige

"Yours very Resp'y.

"ROWE & WOODRUFF."

The evidence and exhibits in the present case undoubtedly show that the defendant is endeavoring to trade on the name of the complainants. If there existed any doubt in the mind of this court that the complainants had some property in and to the name "Pocahontas," which defendant wishes to appropriate, we believe the doubt will be dispelled upon glancing at the two advertising cards at pages 47 and 48 Record, and known as Exhibits O and P.

In the first of these exhibits, marked "O," the most prominent features of the card are the words "Pocahontas"and "Coal," and between these words in small and obscure type is the word "smokeless." In the second of these exhibits, marked "P," the words "Pocahontas" and "Coal" are most prominently displayed, whereas the words "Coke and Coal Co.'s Celebrated," between "Pocahontas" and "Coal," are in small and obscure type.

A reproduction of these two exhibits follow:—

EXHIBIT O.

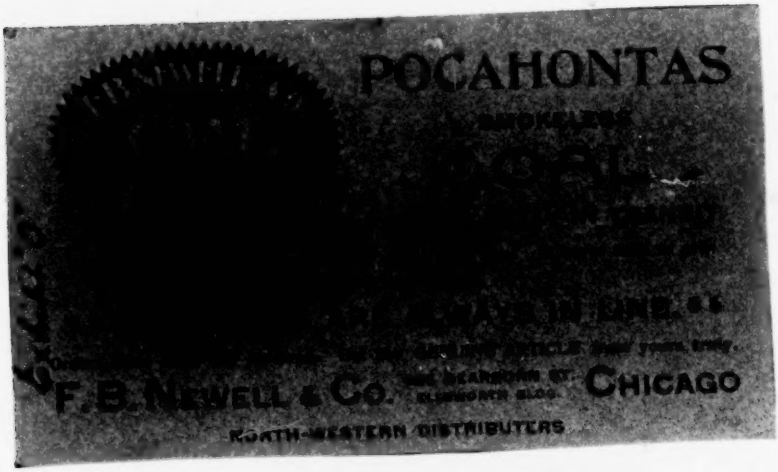

EXHIBIT O (Reverse Side).

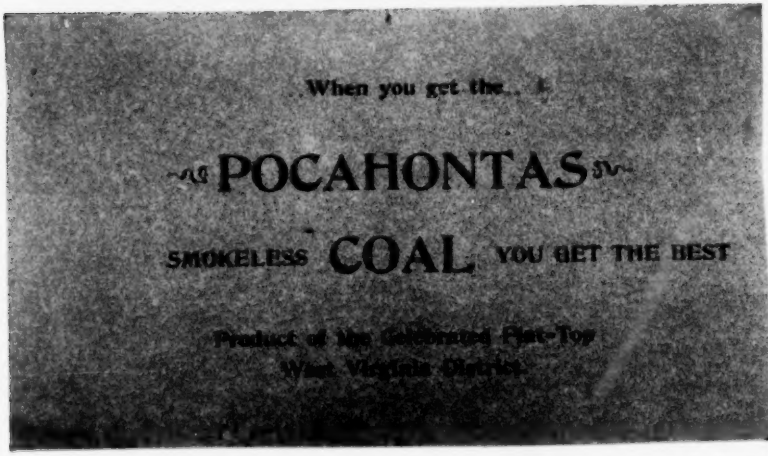

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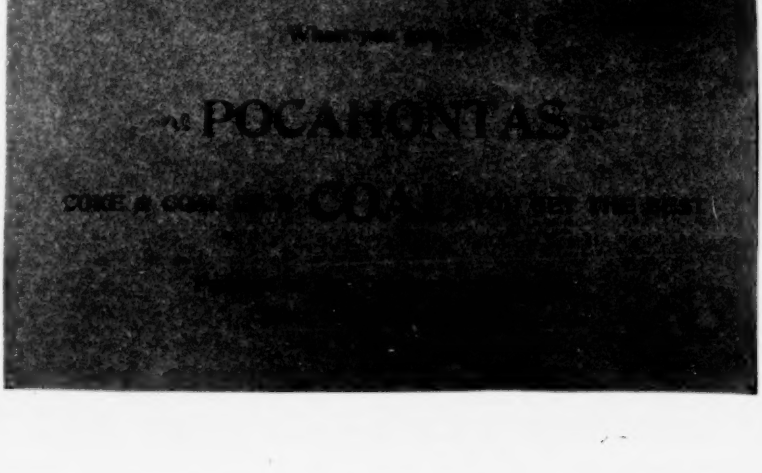
EXHIBIT P.

EXHIBIT P (Reverse Side).



The receipt marked "Exhibit K K" and Exhibit M," the receipt of the Franklin Fuel Company, in which coal is described as "Poca," are further evidence of Coffman's intent to deceive the public. (See pages 44, 50.)

As further evidence that the defendant is desirous of securing some of the advantages accruing to the complainants by virtue of their building up of an immense business under the trade mark "Pocahontas," the fact that the defendant appealed from the preliminary injunction order is significant.

That order (Record, page 146) in substance says to the defendant: You shall not be restrained from advertising your coal as coming from the Pocahontas coal field, but you must not sell your coal as the coal of complainants. If the defendant were honest in his pretensions then he should have been satisfied with this definition of his rights, which definition, we believe, has been uniformly laid down by this court in all cases of trade mark.

APPELLANT-DEFENDANT'S ASSIGNMENTS OF ERROR.

The assignments of error presented by the defendant as appellant to the Circuit Court of Appeals were in substance as follows (page 139, Record):—

I. That the Circuit Court erred in overruling the demurrer of the defendant.

II. That the Circuit Court erred in rendering any decree at all until the merits of the said cause, as put in issue by the pleadings, were fully developed by proofs adduced in the proper order of chancery proceedings and practice.

III. That the Circuit Court erred in entering the injunction order of May 5th, 1897, for the following reasons:—

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First.—Because the names "Pocahontas" and "Pocahontas Flat Top" are geographical names.

Second.—Because the "Pocahontas Section" is alleged to have an area of nine hundred and fifty-one square miles, of which the court is asked to take judicial notice.

Third.—That complainants cannot have the exclusive use of a trade name which would give them the monopoly in a geographical section in the sale of coal other than that handled by them, and such trade mark cannot consist of words in common use, as designating a locality, &c.

Fourth.—That words in common use are the common property of the people, and no one can acquire an exclusive right to such a word by adopting it as a trade mark; and that this is especially applicable to geographical names.

Fifth.—That the word "Pocahontas" is and for many years has been used as identifying a class of coal in a large region, and is descriptive of all the coal in that region.

Sixth.—That from necessity and for the information of the trade, the word "Pocahontas" is absolutely essential to and inseparably connected with the marketing of the coal from that field, and it has for years been used without objection in connection with every institution in the field, and its use is so large it cannot be controlled.

Seventh.—That the word "Pocahontas" has been used by individuals and corporations and institutions all over the country, and complainants are now estopped to claim it as their trade mark.

Eighth.—That complainants failed to show any priority of right to the trade mark.

Ninth.—No fraud was proven.

Tenth.—That complainants are endeavoring to monopolize the coal trade of that vast section.

Eleventh.—Complainants had used the name "Pocahontas" prior to purchase of same from South-West Virginia Improvement Company.

Twelfth.—The trade mark "Pocahontas" is historical and geographical, and was not originated by complainants.

Thirteenth.—That complainants falsely allege the right

to exclusive use of trade mark by reason of some peculiar inspection of the coal; that inspection does not change the coal, and would give no claim to a trade mark for raw material; that the inspection simply consisted in the elimination of foreign substances from the coal, which kind of inspection is common to mines everywhere, particularly this section, and which has been used by defendant's vendors.

Fourteenth.—Complainants have for years been selling as "Pocahontas" the same coal defendant now sells.

No specific disposition of these assignments of error was made by the Circuit Court of Appeals.

The Circuit Court of Appeals Erred in Dismissing the Bill of Complaint.

The appeal was taken by defendant to the Circuit Court of Appeals under section 7 of the Act of March 3d, 1891, entitled "An Act to establish Circuit Courts of Appeals and to define and regulate in certain cases the jurisdiction of the courts of the United States, and for other purposes," as amended February 18th, 1895.

The decision of this court in Smith *vs.* Iron Works, 165 U. S., 518, settled the question that on appeal from an *interlocutory decree*, the Appellate Court may order that the bill be dismissed.

An interlocutory decree is final as to the matters decided by it, and interlocutory in the sense that the court requires proof as to damages and profits before passing a final decree.

It is entered only after a hearing before the court on full pleadings, and upon the depositions of witnesses who have been subjected to cross examination. It is thought a distinction should be made between such a decree and an order for an injunction, as in the present case. Here the questions are presented to the court for determination,

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substantiated only by *ex parte* affidavits. No chance for cross examining the defendant's witnesses was given to complainants.

The opinion of the Fourth Circuit, upon the appeal, commented at length upon the failure of complainants to prove material allegations of the bill. Thus, for instance, it is said (page 155, Record):—

> *"There is no evidence to sustain the allegations in the bill that the South-West Virginia Improvement Company began selling coal in the year 1882, from the 'Pocahontas' mine, nor that it made any sales of 'Pocahontas' coal in the year 1883, in the sense that those words are used in as a trade symbol."*

There is, however, in the record just such evidence. (Record, page 13, and defendants' Exhibit "Iron Belt," page 100 and page 103.) Even if the Fourth Circuit had deemed this evidence insufficient, there would be no warrant upon a motion for preliminary injunction to do aught further than to deny the motion and refuse the injunction until the case could be considered upon *proofs* at final hearing. (See Mayor of Knoxville *vs.* Africa, 23 C. C. A., 252, and also same case upon rehearing, page 262.)

In conclusion, we believe, that there is sufficient equity in the present case to sustain the bill of complaint and the preliminary injunction order heretofore granted thereon. The decree of the Circuit Court of Appeals for the Fourth Circuit should, therefore, be set aside and the injunction re-established.

Respectfully submitted,

HENRY E. EVERDING,
ARTHUR v. BRIESEN,
FREDERICK P. FISH,
Of Counsel for Petitioners.

UNITED STATES CIRCUIT COURT OF APPEALS FOR THE FIRST CIRCUIT.

William C. Atwater & Co., et al., *Defendants, Appellants,* vs. *Samuel Castner, Jr.*, et al., *Complainants, Appellees.*	October Term, 1897. No. 239.

Appeal from the Circuit Court for the District of Massachusetts.

BEFORE PUTNAM, WEBB, AND BROWN, JJ.

OPINION OF THE COURT.

JUNE 1st, 1898.

PUTNAM, J.

This is an appeal from an order granting a temporary injunction, and relates to an alleged trade mark or trade name "Pocahontas" used in the coal traffic. This has been used for fully twenty years by the complainants below and their predecessors in title in a very extensive trade, with unbroken public acquiescence until the controversy out of which this litigation arose in this circuit and in the Fourth Circuit. It does not indicate merely that the complainants below are the producers of the coal sold, but quite as much that it is sorted and put on the market under their implied representation of uniform quality and excellence. In addition to the public acquiescence of which we have spoken, there had been, prior to the injunction order appealed from, an adjudication in the Circuit Court in the Fourth Circuit, sustaining the claimed trade mark or trade name and enjoining its infringement.

It is said that the complainants' coal, and also the alleged infringing coal, come from an extensive locality now generally known under the name of Pocahontas, and it is claimed that the case therefore falls within the rule of Canal Company *vs.* Clark, 13 Wall., 311, and Columbia Mills Company *vs.* Alcorn, 150 U. S., 460. But even if

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this were true in a general sense, it would remain to be considered whether the Supreme Court, in Singer Manufacturing Company *vs.* June Manufacturing Company, 163 U. S., 169, 203, 204, was not compelled to a qualification of the broad principle, claimed to have been stated in the cases referred to, as applied to trade marks and trade names which have been long and extensively used, and have become widely recognized by the public at large, even when they might not have originated in accordance with the ordinary rules of law. In that case the court found that some qualification of the rule that a word which indicates quality cannot be protected as a trade mark or trade name is necessary, at least in some classes of cases; and there is ground for maintaining that this applies with the same necessity to trade marks and trade names which represent well-known localities as to those of the character of that in question in that case. We do not, however, find it necessary to decide at present whether or not any qualification of that nature would be applicable to the case at bar, because so sharp a question does not now arise. Some of the reasons which render it necessary, under some circumstances, to protect, at least to a qualified extent, a trade mark of a geographical origin, were given by us in Levy *vs.* Waitt, 61 Fed. Rep., 1008, 1012.

The exact rule of Columbia Mills Company *vs.* Alcorn is implied in the following statement, at page 464:—

"The word 'Columbia' is not the subject of exclusive appropriation, under the general rule that a word or words in common use as designating locality or section of a country cannot be appropriated by any one as his exclusive trade mark."

This is explained in the same opinion, at page 465, by citing from Canal Company *vs.* Clark, *ubi supra*, the following expression:—

"The word 'Lackawanna' was not devised by the complainants. They found it a settled and known appellative of a district in which their coal deposits and those of others were situated. At the time they began to use it, it was

a recognized description of the region, and, of course, of the earth and minerals in the region."

It is necessary to recognize carefully the distinction which these expressions imply. Otherwise, a manufacturer, producer, or dealer who furnishes goods of such excellent quality that they build up so extensive a trade as to give a distinctive name to the locality where it is pursued, would be defeated of the just fruits of his industry and integrity by the very fact of his own meritorious conduct. Therefore, even under the rule as stated in the Columbia Mills Company *vs.* Alcorn, *ubi supra*, and without the qualification recognized in Singer Manufacturing Company *vs.* June Manufacturing Company, *ubi supra*, the case at bar as presented to the court below and also to this court, involves a difficult question of fact, to the effect whether at the time the trade mark or trade name in question was adopted the word Pocahontas was in common use as designating a known locality, or whether the locality gained its name from the complainants. Therefore, the Circuit Court was not met with a pure question of law, but with a mixed question of law and fact; and, by the well-settled principles touching the granting of temporary injunctions, the court was fully justified in its action by the long and unbroken public acquiescence, without reference to the adjudication in the Fourth Circuit to which we have referred.

The defendants below suggest that the acquiescence was not unbroken, as stated by us, because the affidavits show that there was one dealer, Browning, who shipped his coal as Pocahontas coal, but they also show that all such coal was plainly tagged as follows: "Pocahontas coal, from the Browning mines." This, so far from interrupting the public acquiescence to which we have referred, supported it by an evident attempt on the part of Browning to bring himself within the rule stated in Singer Machine Company *vs.* June Manufacturing Company.

Since the granting of the injunction in the case before us by the court below, and since the appeal to this court and the arguments at bar on the appeal, the Circuit Court

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of Appeals for the Fourth Circuit, in Coffman *vs.* Castner, by an opinion passed down May 3d, 1898, has held that the claimed trade mark or trade name Pocahontas cannot be sustained, and has reversed the adjudication of the Circuit Court to which we have referred, and has remanded the cause to that court with instructions to dismiss the suit. As the complainants in this case were the complainants in the case in the Fourth Circuit, it may be that if this had occurred before the action of the court below, now appealed from, no temporary injunction would have been granted. But, as the injunction was granted before the decision of the Circuit Court of Appeals was announced, the position is radically different. The order was clearly proper when made; and, if the circumstances remained unchanged, we could not reverse it. If the decision in the Fourth Circuit were in all respects final, we should hesitate to allow the injunction to continue, especially as the parties complainant are the same in each case. It is, however, not final, as it may be reversed, possibly, on a writ of *certiorari* from the Supreme Court. It would not be seemly for the courts in one circuit to grant, dissolve, and perhaps renew temporary injunctions according to varying conditions of litigations in other circuits; so that, as this injunction was clearly proper when granted, our only suitable course is not to interfere with it for any reason now apparent to us.

We, of course, do not mean to limit the usual powers of the court below over the injunction, as, while we accept the usual form of order, we attach to it the qualifications stated by us in Davis Electrical Works *vs.* Edison Electric Light Company, 60 Fed. Rep., 276, 282.

Some incidental matters were brought to our attention by the parties, but we believe all of them are rendered unimportant in view of the conclusions which we have stated. As neither party takes from our decision anything substantial, and as the circumstances are without precedent, we are not satisfied that equity requires that the appellants should pay the costs of this appeal.

The order appealed from is affirmed, neither party to recover costs of appeal.

NOTE BY THE COURT.—Pillsbury Washburn Flour Mills Co. *vs.* Eagle, 86 Fed. Rep., 608, which came to hand since our opinion was passed down, fully sustains our suggestions about trade names of geographical origin.

OPINION ON PETITION FOR REHEARING.

Atwater *et al.* vs. Castner *et al.* (Circuit Court of Appeals, First Circuit. November 17th, 1898). No. 239. Appeal from the Circuit Court of the United States for the District of Massachusetts. This was a suit to enjoin the infringement of an alleged trade mark or trade name in the word "Pocahontas," as applied to coal. The Circuit Court having made an order granting a temporary injunction, defendants took an appeal, and this court on June 1st, 1898, rendered an opinion affirming the order. 32 Circuit Court of Appeals, 77, 88 Fed., 642. The cause is now heard on a petition filed by the appellants, asking that the mandate be recalled and a rehearing ordered. Causten Brown and Jennings & Morton, for petitioners. Before PUTNAM, Circuit Judge, and WEBB and BROWN, District Judges.

PUTNAM, Circuit Judge: Our opinion on the merits of this appeal was passed down on June 1st, 1898, and the judgment in accordance therewith was entered on the same day. A mandate, pursuant to the judgment issued on June 9th, 1898, with the knowledge of appellants and without objection from them. On September 30th, 1898, during the term at which the judgment was entered and the mandate issued, the appellants filed with the clerk, without leave, a petition that the mandate be recalled and that a rehearing be ordered. The proceeding must be governed by the practice as it existed before the adoption at this term of amended rule 29. We have carefully examined the petition and the petitioners' brief, but none of the judges who concurred in the judgment desires that the case be argued anew. The ordinary judgment would be that the petition be denied, but, under the circumstances, the proper and more prudent course is to dismiss it. The petition that our mandate be recalled and a rehearing be ordered is dismissed.

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